APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,163	01/28/1999	HIROSHI SUMIYAMA	032567-002	6659

21839 7590 05/13/2005		EXAMINER
BURNS DOANE SWECKER & MATHIS L L P		POKRZYWA, JOSEPH R
POST OFFICE BOX 1404	ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22313-1404	2622	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action ***Before the Filing of an Appeal Brief***	Application No. 09/238,163	Applicant(s) SUMIYAMA ET AL.	
	Examiner Joseph R. Pokrzywa	Art Unit 2622	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

  a) ☒ The period for reply expires <u>3</u> months from the mailing date of the final rejection.

  b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

    Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

<u>NOTICE OF APPEAL</u>

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

<u>AMENDMENTS</u>

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will <u>not</u> be entered because

  (a)☐ They raise new issues that would require further consideration and/or search (see NOTE below);

  (b)☐ They raise the issue of new matter (see NOTE below);

  (c)☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

  (d)☐ They present additional claims without canceling a corresponding number of finally rejected claims.
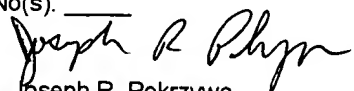
    NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

  The status of the claim(s) is (or will be) as follows:

  Claim(s) allowed: _____.

  Claim(s) objected to: _____.

  Claim(s) rejected: _____.

  Claim(s) withdrawn from consideration: _____.

<u>AFFIDAVIT OR OTHER EVIDENCE</u>

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will <u>not</u> be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will <u>not</u> be entered because the affidavit or other evidence failed to overcome <u>all</u> rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

<u>REQUEST FOR RECONSIDERATION/OTHER</u>

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: <u>of the reasons discussed in the attached action.</u>

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). ____

13. ☐ Other: _____.

Joseph R. Pokrzywa
Primary Examiner
Art Unit: 2622

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 4/4/05 have been fully considered but they are not persuasive.

2.   In response to applicant's arguments regarding the rejection of claim 1, which was cited in the Office action dated 1/7/05, as being unpatentable over Hirata *et al.* (U.S. Patent Number 5,113,520) in view of Ohta (U.S. Patent Number 5,448,376), whereby applicant argues on pages 1 and 2 that Ohta fails to teach of storing image forming conditions in the ROM 11, since Ohta teaches of storing information concerning "candidate images" which are to be identified and deleted from image data. Because of this, applicant argues that Ohta fails to teach of causing the output unit to output image data newly input from the image input unit after the discarding of image data from the first memory under the maintained image forming conditions.

Currently, claim 1 requires " a second memory for storing image forming conditions", and "an image output unit for printing the image data stored in the first memory under the image forming conditions stored in the second memory". Thus, "image forming conditions" are defined by the requirement of "printing the image data under the image forming conditions". Thus, using a broad, reasonable interpretation of the term "image forming conditions", one can recognize that Ohta's standard geometry parameters stored in the ROM 11 can, in fact be image forming conditions. In Ohta, image data that is printed out is done so "under the image forming conditions stored in the second memory", as image data is printed "under the condition" that it

does not match the data stored in the second memory. Because of this, it can be recognized as an image forming condition.

Continuing, the primary reference of Hirata teaches of each of the limitations, including an output control means for causing the output unit to output image data newly input from the image input unit under the maintained image forming conditions, as read in column 4, lines 37 through 57, wherein as seen in Fig. 3B, at step S260, when an execute print key is pressed, image data which was newly input by the image input unit, noted as the keyboard 10, is printed during the printing routine in step S290. However, Hirata does fail to expressly disclose of outputting image data newly input from the image input unit after the discarding of image data from the first memory under the maintained image forming conditions. Ohta is being utilized to teach this feature. Particularly, Ohta teaches of means for causing an output unit to output image data newly input from the image input unit after the discarding of image data from the first memory under maintained image forming conditions, as read in column 8, lines 3-41.

With this, it would have been obvious to a person of ordinary skill in the art to consider Hirata's system to output image data newly input from the image input unit after the discarding of image data from the first memory under the maintained image forming conditions, as recognized by Ohta. The suggestion/motivation for doing so would have been that Hirata's system would become more efficient with the addition of Ohta's teachings, since image forming parameters would not need to be reloaded for each newly input image, as recognized by Ohta in column 1, line 37-column 2, line 59. Therefore, it would have been obvious to combine the teachings of Ohta with the system of Hirata to obtain the invention as specified in claim 1.

3.   Therefore, the rejections of independent **claim 1**, as well as independent **claims 10, 16,**

and 19, cited in the Office action dated 1/7/05 as being unpatentable over Hirata *et al.* in view of
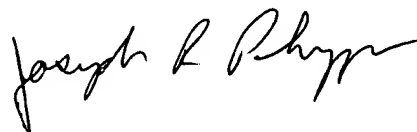
Ohta, are maintained.

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The

examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622

jrp